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JUL 21 2005

Technology Center 2100

In re Application of: Mikami
Application No. 10/743,727
Filed: 24 December 2003
For: METHOD, APPARATUS, AND
COMPUTER READABLE MEDIUM FOR
MANAGING REPLICATION OF BACK-UP
OBJECT

DECISION ON PETITION
TO MAKE SPECIAL
(ACCELERATED EXAMINATION)
UNDER M.P.E.P. § 708.02 (VIII)

This is a decision on the petition filed 16 May 2005 and the supplement submitted 13 June 2005, under 37 C.F.R. 102(d) and M.P.E.P. § 708.02(VIII): Accelerated Examination, to make the above-identified application special.

The Petition is **DISMISSED**.

M.P.E.P. § 708.02, Section VIII which sets out the prerequisites for a grantable petition for Accelerated Examination under 37 C.F.R. § 102(d) states in relevant part:

A new application (one which has not received any examination by the examiner) may be granted special status provided that applicant (and this term includes applicant's attorney or agent) complies with each of the following items:

- (a) Submits a petition to make special accompanied by the fee set forth in 37 CFR 1.17(h);
- (b) Presents all claims directed to a single invention, or if the Office determines that all the claims presented are not obviously directed to a single invention, will make an election without traverse as a prerequisite to the grant of special status;
- (c) Submits a statement(s) that a pre-examination search was made, listing the field of search by class and subclass, publication, Chemical Abstracts, foreign patents, etc. The pre-examination search must be directed to the invention as claimed in the application for which special status is requested. A search made by a foreign patent office satisfies this requirement;
- (d) Submits one copy each of the references deemed most closely related to the subject matter encompassed by the claims if said references are not already of record; and

- (e) Submits a detailed discussion of the references, which discussion points out, with the particularity required by 37 CFR 1.111 (b) and (c), how the claimed subject matter is patentable over the references.

In this case, the petition/supplement fails to adequately meet requirement (e) as set forth above. Responsive to requirement (e), applicant must provide a “detailed discussion of the references, which discussion points out, with the particularity required by 37 CFR 1.111 (b) and (c), how the claimed subject matter is patentable over the references.” Petitioner should ensure that the above discussion is directed to *how the language of each of the independent claims are specifically distinguishable and patentable from the references* provided pursuant to requirement (d) supra.

The petition filed 16 May 2005 and the supplemental petition filed 13 June 2005, both fail to discuss the **claimed limitations** with respect to the references in accordance with the requirements of 37 CFR 1.111 (b) and (c). In the initial petition, submitted 16 May, there is no indication of which claims correspond to the featured language that Applicant proffers as the basis for patentability in the discussion of each reference. The petition recites claims 1, 2 and 8, the independent claims prior to addressing the references. Then, in the discussion of each reference, Petitioner alludes to some features from the claimed invention that the reference lacks. This featured limitation language, however, does not point to or refer to any specific claim. Petitioner is required to submit a **detailed discussion that includes identifying claim limitations with particularity for each independent-claim** that cannot be found in the relevant prior art references.

It appears that Petitioner has attempted to ameliorate the foregoing deficiency in the discussion of the references with the supplemental petition filed 13 June. The supplemental petition does mention claims 1 and 2 in the discussion of each reference. Specifically, Petitioner inserts an averment at the end of each reference discussion that the reference “does not disclose or suggest the above described first feature of the present invention as recited in independent claim 1, and the above described second feature of the present invention as recited in independent claim 2, in combination with the other Limitations recited in each of the independent claims.” Despite the fact that the supplement does add mention of two of the independent claims, it fails to point out the patentable limitations with particularity in each of the independent claims with respect to each given reference. The supplement indirectly refers to some features “in combination with the other Limitations recited in each of the independent claims.” From this, it is unclear which limitation or combination of limitations constitute the patentable distinctions not found in the prior art reference. Which claims and elements come within the penumbra of “Limitations recited in each of the independent claims”? Does this term represent the collective intersection of limitations in claims 1, 2 and 8, each of the independent claims? Furthermore, the Petition does not bring up claim 8 with respect to each of the references. This discussion does not provide the requisite specificity regarding the limitations associated with each of the independent claims for correlation/contrast with the referenced prior art.